

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT Application of
Mills

Group Art Unit: 1745

Application No. 09/009,294

Examiner: Kalafut

Filed: January 20, 1998

For: HYDRIDE COMPOUNDS

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September 10, 2001

**REQUEST FOR RECONSIDERATION UNDER MPEP § 706.07 THAT THE
EXAMINER WITHDRAW THE FINALITY OF THE PENDING OFFICE ACTION**

-AND-

**CONDITIONAL RULE 181 PETITION TO THE GROUP DIRECTOR
REQUESTING RECONSIDERATION IF THE EXAMINER DENIES
REQUEST UNDER MPEP § 706.07 THAT THE FINALITY
OF THE PENDING OFFICE ACTION BE WITHDRAWN**

Hon. Asst. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

Applicant submits that the finality of the Office Action, dated July 3, 2001, is premature and should be withdrawn for the reasons set forth below.

Request For Reconsideration Under MPEP § 706.07

For procedural purposes, Applicant requests that this paper first be considered a request under MPEP § 706.07 to Primary Examiner Kalafut to reconsider the finality of the Office Action. MPEP §§ 706.07(c) and (d) provide:

(c) Any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c). [Emphasis added.]

(d) If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection. The finality of the Office action must be withdrawn while the application is still pending. The Examiner cannot vacate the final rejection once the application is abandoned. [Emphasis added.]

Thus, under MPEP §§ 706.07(c) and (d), Applicant can file a request for reconsideration of the finality of an Office Action with the Primary Examiner at any time during pendency of the Final Office Action. If the Primary Examiner denies the request, Applicant can then file a Rule 181 petition to have the Group Director review the Primary Examiner's refusal to withdraw the finality under MPEP § 1002.02(c)(3)(a).

Applicant's counsel telephoned Examiner Kalafut within two months of the mailing date of the Office Action and requested that he withdraw the finality of the pending Office Action. Examiner Kalafut indicated his preference that the request for withdrawal be filed in writing. In accordance with the Examiner's wishes, the present request is submitted and, having been filed during the pendency of the Office Action complained of, it is considered timely filed under MPEP § 706.07.

Conditional Rule 181 Petition

Should the Primary Examiner deny Applicant's request for reconsideration and withdrawal of the finality of the pending Office Action, Applicant further requests that this paper further be considered a petition to the Group Director under Rule 181 to review the finality of the Office Action and withdraw the same. If a petition fee is required, please charge any deficiency to our Deposit Account No. 50-0687 under Order No. 62-226.

The Rule 181 petition, if necessary, will be timely since the two-month period for filing the petition under Rule 181(f) does not begin to run until the Primary Examiner denies Applicant's initial request for reconsideration of the finality of the Office Action. See MPEP § 1002, page 1000-2, right column, third paragraph from bottom, which states:

37 CFR 1.181(f) provides that any petition under that rule which is not filed "within 2 months from the action complained of may be dismissed as untimely." Often, the "action complained of," for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a 3-month period for reply. Under such circumstances, if applicant requests reconsideration, under 37 CFR 1.111(b), of the requirement for a new drawing, the examiner's action on this request, if adverse, establishes the beginning of the 2-month period for filing the petition. The petition must be filed within this period even though the period for reply to the rejection of the claims may extend beyond the 2-month period. [Emphasis added.]

Basis For Applicant's Request For Withdrawal of Finality
And, If Necessary, Rule 181 Petition To The Group Director

Applicant respectfully submits that the finality of the pending 68-page Office Action, dated July 3, 2001, is premature due to the introduction of new grounds of rejection that were neither necessitated by amendment of the claims, nor based on information submitted in an information disclosure statement. For this reason and the others presented below, the finality of that Office action should be withdrawn.

The troubling procedural history of this case is well documented in other papers on file and, therefore, Applicant will forego a full accounting of the sordid details in this Request. Suffice it to say that, following the initial allowance of the claims after a thorough review of the evidence then of record by Examiner Kalafut, the PTO has articulated different positions and legal standards, while ignoring Applicant's supporting evidence, which actions culminated in a rejection of those same claims by a "Secret Committee" in the Office Action dated September 1, 2000. Applicant's response to that Office Action, dated March 1, 2001, pointed out those deficiencies without amending

the claims, particularly the Secret Committee's failure to consider the scientific evidence that was already of record and its failure to address the supposed shortcomings in Applicant's underlying theory.

While the Secret Committee's Final Office Action fails to overcome those deficiencies, it did for the very first time address some, though not all, of the initially-presented experimental evidence that was the basis for the Examiner's initial allowance of the claims.

For example, on page 57, last paragraph through page 58, second paragraph of the Final Office Action, the Secret Committee newly addresses experimental evidence that was presented in the originally-filed application. It is blatantly unfair for the Committee to wait until the final Office Action to address this evidence for the first time, especially in light of the procedural history of this case.

To cite another example, on pages 49-61 of the pending Office Action, the Secret Committee discusses for the first time in any detail its position on the calorimetric experimental data of record. The Committee's position on this calorimetric evidence should have been presented in the first Office Action on the merits, not in the second, FINAL Office Action now pending.

On pages 50-54, paragraph 21 of the Office Action, the Secret Committee details its position for the first time regarding the NASA Technical Memorandum (Exhibit 29). The NASA Technical Memorandum, however, was already made of record over two years ago, having been submitted in Applicant's Information Disclosure Statement dated May 21, 1999, and was fully considered by Examiner Kalafut prior to the Allowance of the application. For the Committee to express its views of this scientific evidence for the first time in a Final Office action is improper.

On page 53 of the Office Action, the Secret Committee newly advances its position regarding Shkedi, Z. et. al., Fusion Technology, vol. 28, 17720-1731 (1950). Once again, this article was already considered by Examiner Kalafut over two years ago

prior to the Allowance of the Application when it was submitted in the Information Disclosure Statement dated May 21, 1999.

On pages 56-61, paragraph 24 in the Office Action, the Secret Committee details its position for the first time regarding the spectroscopic data that was disclosed over three years ago in the original application, filed on January 20, 1998. Examiner Kalafut, fully considered this experimental evidence in allowing the present application.

The Secret Committee cites 27 new so-called "state-of-the-art" books and journals on pages 67 and 68 of the Office Action, and in the Form PTO-892. Again, it is improper for the Committee to force Applicant to respond to these numerous articles in a Final Office Action.

In addition, throughout its 68-page Final Office Action, the Secret Committee takes issue with various aspects of Applicant's theory that were never previously discussed, and which discussions could have and should have been presented earlier so as to develop a clear issue prior to appeal.

For instance, the Secret Committee discusses for the first time certain details of Applicant's book, which was incorporated by reference on page 3 of the original application filed on January 20, 1998. See, for example, citations to Applicant's book on pages 10, 13, 16, 17, 18, 20 and 23 of the Office Action. The Secret Committee explains that it consulted Applicant's book "to better understand applicant's invention." [page 5, last sentence of final Office Action.] The Committee, however, provides no explanation as to why it waited until the pending final Office Action to consult with and criticize sections of Applicant's book.

In Sections 11 and 12, on pages 25 and 26 of the Office Action, the Secret Committee discusses for the first time its position regarding the paper co-authored by Mills and Kneizys (Exhibit 27). Once again, this article was submitted in the Information Disclosure Statement dated May 21, 1999, and thus fully considered by Examiner Kalafut over two years ago prior to the Allowance of the Application.

The above-cited examples are but a few of the instances in which the Secret

Committee has raised new issues for the first time in its Final Office Action. There are many other instances – for example, throughout sections 5, 6 and 8 of the Final Office Action – in which the Secret Committee for the first time advances many new positions regarding Applicant's theory, which should have been raised in the first Office Action.

In view of all these circumstances, the finality of the July 3 Office Action is premature and, therefore, should be withdrawn. As the PTO's own procedural guidelines, MPEP § 706.07(a), make clear:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). [Emphasis added.]

The Secret Committee has not cited—nor can it cite—to any amendment of the claims or information submitted in an information disclosure statement that necessitated the finality of the July 3 Office Action.

What is truly ironic here is that only after Applicant complained bitterly in the March 1, 2001 Response leading up to the Final Office Action that the Secret Committee had failed to provide a full and fair hearing on the scientific evidence presented and had failed to fully address the supposed shortcomings of Applicant's theory did it articulate some of its views on those subjects in the July 3 Office Action. To then make those views "final" without the opportunity for rebuttal prior to appeal is blatantly unfair.

Indeed, the PTO's own procedural guidelines, as found in MPEP § 706.07, highlight the unfairness of the Secret Committee's action:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. . . .

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

These worthwhile goals of providing a full and fair hearing and developing a clear issue before appeal cannot possibly be achieved when evidence previously made of record is analyzed to reject claims for the first time in a Final Office Action. Similarly, these goals go unmet when most of the 68-pages of that Final Office Action address for the first time alleged deficiencies in Applicant's theory that could have and should have been articulated in its previous Office Action.

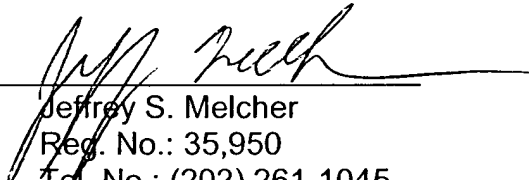
CONCLUSION

Based on the foregoing reasons, the Final Rejection entered in this case was premature and, therefore, withdrawal of the finality of that rejection is in order.

Respectfully submitted,

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